

ESTTA Tracking number: **ESTTA247286**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047013
Party	Defendant Internet FX, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,064,820
Mark: NETTRAK
Registered: March 7, 2006

NeTrack, Inc.,)	Cancellation No. 92047013
)	
Petitioner,)	
)	
v.)	REGISTRANT'S MOTION TO STRIKE
)	PETITIONER'S NOTICE OF RELIANCE
Internet FX, Inc.,)	FILED OCTOBER 14, 2008 AND
)	EXHIBITS THERETO (ESTTA NO.
Registrant.)	242652)
)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

INTRODUCTION

In accordance with Rule 2.122 of the Trademark Rules of Practice and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 533 and 707.02, Registrant moves the Board to strike a Notice of Reliance submitted by Petitioner Netrack, Inc. Specifically, Registrant moves the Board to strike Petitioner's Notice of Reliance filed October 14, 2008 (ESTTA 242652) (hereinafter, "Notice of Reliance") to the extent it notices reliance on Petitioner's testimony Exhibits H, and J through Y.¹ By the subject Notice of Reliance, Petitioner attempts to improperly make of record the following categories of items that are not printed publications pursuant to Rule 2.122(e) and not otherwise admissible: (1) Internet printouts; and (2) documents from a private database provider not consisting of printed publications available to the general public or libraries of general circulation.

¹ Petitioner made seven (7) filings entitled "Notice of Reliance" on October 14, 2008. This Motion to Strike is specifically directed at ESTTA Tracking No. ESTTA 242652.

A. The Internet Printouts Submitted Under Petitioner's Notice of Reliance as Exhibits H and K Through Y are Inadmissible Under Rule 2.122(e) Because They are Not Printed Publications

At Exhibits H and K through Y, Petitioner submitted Internet printouts with its Notice of Reliance citing to Rule 2.122(e) of the Trademark Rules of Practice, which provides that “[p]rinted publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding . . . may be offered into evidence by filing a notice of reliance on the material being offered.” C.F.R. § 2.122(e).

The Board has repeatedly ruled that Internet website printouts are not admissible through a Notice of Reliance. See *Michael S. Sachs, Inc. v. Cordon Art, B.V.*, 56 U.S.P.Q.2d 1132 (T.T.A.B. 2000) (explaining that an Internet printout showing 427 individuals with the surname “Escher” could not be introduced by a Notice of Reliance); *CSX IP, Inc. v. Greenbriar*, Opposition. No. 109,424, 2000 WL 1279498, *1 (T.T.A.B. Aug. 25, 2000) (explaining that it is well-settled that Internet printouts are not admissible under Rule 2.122(e) because they are not considered printed publications); *Food-Tek, Inc. v. Rhodia, Inc.*, Opposition. No. 99,676, Cancellation No. 24,523, 1999 WL 1004645 (T.T.A.B. Nov. 3, 1999) (stating that Internet printout of association newsletter would not be accepted under a Notice of Reliance); *Smith Kline Beecham Corp. v. Xechem, Inc.*, Opposition No. 102,846, 1998 WL 887254 (T.T.A.B. Dec. 18, 1998) (refusing to consider Internet printouts under a Notice of Reliance because they are not printed publications); *Raccioppi v. Apogee Inc.*, 47 U.S.P.Q.2d 1368, 1370 (T.T.A.B. 1998) (explaining that “the element of self-authentication which is essential to qualification under Rule 2.122(e) cannot be presumed to be capable of being satisfied by Internet printouts”; permitting introduction of printouts only for purposes of summary judgment when introduced through declaration of attorney who accessed the website and printed the documents). The documents Petitioner seeks to have admitted under its Exhibits H, and K through Y of its Notice of Reliance are Internet printouts, and therefore are not admissible under a Notice of Reliance.

B. Separately, the Printout at Exhibit J of the Notice of Reliance Is Inadmissible Under Rule 2.122(e) Because It Does Not Meet the Requirements of a Printed Publication.

At Exhibit J to its Notice of Reliance, Petitioner submitted a printout entitled in the upper left-hand corner “SAEGIS Full Text Record”; however, this printout is not the official record of a public office or agency and does not meet the requirement of “[p]rinted publications, such as books and periodicals.” To be admissible as such, “printed publications” must be “available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue.” 37 C.F.R. 2.122(e). Exhibit J to the Notice of Reliance is a printout from a private database provider which extracts or synthesizes the contents of other documents. Such documents have been held inadmissible by the Board. *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 U.S.P.Q. 2d 1883, 1884 n.3 (T.T.A.B. 1993) (finding trademark search report inadmissible); *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 U.S.P.Q. 169, 174-75 (T.T.A.B. 1985) (printouts from databases which themselves comprise abstracts or syntheses of published documents unlike the actual text of documents are hearsay). Because this document is not admissible under a Notice of Reliance and has not been made of record by any other acceptable means, it must be stricken by the Board.

C. The Fact that Registrant Produced the Subject Documents Pursuant to Document Requests Does Not Make Such Documents Admissible.

There is no provision in the Trademark Rules by which a party may notice reliance on documents that were produced by an adverse party in response to a document production request. Documents produced in discovery may be made of record by a notice of reliance to the extent (if any) that the documents happen to be printed publications or official records. *See* 37 C.F.R. § 2.120(j)(3)(ii). Contrary to Petitioner’s statement, such documents are not “effectively authenticated,” (*see* Notice of Reliance at 1), merely because they have been produced by Registrant in response to a request for production. *See* 37 C.F.R. § 2.120(j)(3)(ii).

D. Petitioner's Attempted Reliance on an Interrogatory Answer for Admission of Exhibits H, and J Through Y Is Improper.

In the opening paragraph of its Notice of Reliance, Petitioner refers to an answer to "Interrogatory No 9 of Petitioner's First Set of Interrogatories to Registrant" as a purported basis for the Notice of Reliance. (See Notice of Reliance at 1.) A party seeking to notice reliance on documents purportedly produced in response to an interrogatory must follow the following procedure: (1) specify in the notice of reliance and make of record a copy of the particular interrogatory; (2) indicate generally the relevance of the documents; and (3) identify with some degree of particularity, the nature of each of the documents. See *M-Tek Inc. v. CVP Systems Inc.*, 17 U.S.P.Q. 2d 1070, 1073 (T.T.A.B. 1990) (notice of reliance failed to indicate that documents were being introduced under Rule 2.120(j)(3)(i) by specifying and making of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer).

Here, Registrant did not provide documents in response to the question in any particular interrogatory, with the result that Registrant has not identified or authenticated any of the materials at Exhibits H, and J through Y. Nonetheless, to support admission of these otherwise inadmissible documents (see Sections A & B *supra*), Petitioner has attempted to rely upon a highly generalized "catch-all" interrogatory that is not targeted any specific subject matter. Interrogatory No. 9 is directed to "all documents consulted, referred to or relied on by Registrant." The text of Petitioner's Interrogatory No. 9 and Registrant's response are provided below:²

INTERROGATORY NO. 9:

Identify all documents consulted, referred to or relied on by Registrant in responding to the foregoing interrogatories.

² Petitioner has filed its Notice of Reliance with respect to Interrogatory No. 9 under its Notice of Reliance dated October 15, 2008.

RESPONSE TO INTERROGATORY NO. 9:

Registrant objects to this Interrogatory to the extent it seeks information protected by the attorney-client privilege, attorney work-product or that is otherwise protected from disclosure, and/or that is confidential and proprietary business information. Subject to this objection and the General Objections, and pursuant to FRCP 33(d) Registrant, refers Petitioner to Document Nos. NET 00001 through NET 00310, and other documents which will be produced subject to entry of an appropriate Protective Order.

Here, Petitioner has failed to meet the requirements of Trademark Rule 2.120(j)(3)(i), because it has not specified and made of record a copy of the particular interrogatories to which each document was provided in lieu of an interrogatory answer. In fact, Petitioner has no way to make a record copy of the particular interrogatory to which each of Exhibits H - Y was provided, because Registrant did not specify any particular interrogatory to which any of Document Nos. NET 00001 through NET 00310 were responsive.

Registrant's response to Interrogatory No. 9 provides no more than a broad group reference to documents "consulted, referred to, or relied on" under Document Nos. NET 00001 through NET 00310. Moreover, Petitioner's Exhibits H through Y attached to the Notice of Reliance comprise only a small portion of Document Nos. NET 00001 through NET 00310. Due to this lack of relationship to any particular interrogatory topic, it cannot be determined whether or not any particular document in Document Nos. NET 00001 through NET 00310 comprises an answer or indicates lack of relevant information in regard to any specific interrogatory topic of Petitioner. Furthermore, given that Petitioner has improperly attempted a Notice of Reliance based on a large number of "registrant-produced" documents without relevance to any particular interrogatory, Registrant has no basis for introduction of any of its other interrogatory answers which the Board should consider to clarify the context of the proponent's evidence. *See Holiday Inns, Inc. v. Monolith Enterprises*, 212 U.S.P.Q. 949 (TTAB 1981) (requiring each clarifying

response to be pin-pointed and explained in relation to the responses introduced by the proponent).

Absent a specific tie to a specific interrogatory answer, the proper way for Petitioner to identify and authenticate Petitioner's Exhibits H – Y would be through a testimonial deposition pursuant to Trademark Rule 2.123 or 2.124. Only in the context of a deposition would the material be properly identified and authenticated by a competent witness. Furthermore, Exhibits H, and J – Y lack any basis for self-authentication pursuant to Trademark Rule 2.122(e). As a result, Petitioner's Exhibits H, and J through Y should not be considered by the Board as record evidence in this case.

E. Registrant Bears the Burden of Showing Admissibility

To the extent there is any doubt concerning the admissibility of the documents Petitioner submitted in connection with its Notice of Reliance, Petitioner, as the offering party, bears the burden of showing that the documents are admissible. *Cf. Glamorene Prods. Corp. v. Earl Grissmer Co.*, 203 U.S.P.Q. 1090, 1092 n.5 (T.T.A.B. 1979).


II. CONCLUSION

For the forgoing reasons, Registrant requests that the Board strike Petitioner's Notice of Reliance filed October 14, 2008 under ESTTA Tracking No. ESTTA 242652 and the accompanying documents attached as Exhibit H, and J through Y thereto.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Dated: November 6, 2008

By: 
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing **REGISTRANT'S MOTION TO STRIKE PETITIONER'S NOTICE OF RELIANCE FILED OCTOBER 14, 2008 AND EXHIBITS THERETO (ESTTA NO. 242652)** has been served upon the Petitioner by depositing it with the United States Postal Service as first class mail, postage prepaid, in a sealed envelope addressed to:

Carl Oppedahl, Esq.
Oppedahl Patent Law Firm, LLC
P. O. Box 4850
Frisco, CO 80443-4850

on this 6th day of November, 2008.



Linda Allen